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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,712	01/09/2006	Tacconi Enrico	0002353USU/3061	9835

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EXAMINER

NGUYEN, TAM M

ART UNIT	PAPER NUMBER
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3764

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/541,712

Applicant(s)

ENRICO, TACCONI

Examiner

Tam Nguyen

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities:

In claim 1, on line 3, is the phrase "by means of joints". It should be rephrased as --by means of a joint-- since each footrest only has one joint.

In claim 1, on line 4, is the phrase "the plane containing the base". It should be rephrased as --a plane containing the base-- since this is the first time that that plane has been introduced.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the applicant has disclosed new matter in the amendment to claim 1. Specifically, applicant is now disclosing that the joint is "located in a position which is coincident or higher than the barycenter" of the footrest whereas the original specification only disclosed that the joint is located/attached to the barycenter of the footrests; thus the displacement of the joint in

Art Unit: 3764

reference to the barycenter of the footrest is considered new matter. Claims 2-8 are also rejected as being dependent on a rejected base claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 describes the invention in terms of a particular user by stating that the "footrest comprises dimensions suitable for resting one or both feet". Therefore, whether a device falls within the scope of the claims cannot be ascertained until a particular user engages the device. Consequently, the claim is indefinite. Ex parte Brummer, 12 USPQ2d 1653 (BdPatApp & Inter 1989).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daninos (FR2510895) in view of Duncan (6,019,712).

4. As to claims 1-7, Daninos discloses a footstool device comprising at least one circular footrest (1) and one base (3) attached to the footrest via a ball and socket joint (2) wherein the footrest is composed of a solid bowl with an internal cavity containing a

Art Unit: 3764

liquid mobile mass inside said cavity, the footrest can tilt in various directions without touching the ground or the base and the footrest includes a layer of nonslip material on an upper surface (see ABSTRACT, Figs. 1, 6 & 7). Daninos does not disclose that the ball and socket joint is located in a position which is coincident or higher than the footrest's barycenter. Duncan discloses a similar footstool exercise device having an annularly shaped footrest having a movable mass inside (see Fig. 4). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to change the shape of Daninos' footrest to a more annularly shaped bowl to give a user greater control over the balance of the footstool via a lower center of gravity while maintaining the challenge of having a movable mass inside the foot rest. Furthermore, a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Note, the amended shape of Danino's footrest would allow for the ball and socket joint to be located in a position that is coincident or higher than the barycenter of the footrest.

5. As to claim 8, Daninos discloses a modified footstool as described above. Daninos does not disclose that the base includes non-slip rubber pads. The examiner takes Official Notice that the prior art includes exercise devices having non-slip rubber pads. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine non-slip rubber pads to Daninos' base to provide the footstool with a floor gripping means to provide a more stable base for the user to exercise thereupon.

Response to Arguments

6. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed November 3, 2006 have been fully considered but they are not persuasive. In particular, regarding claim 8, applicant contends that it would not have been obvious to a person of ordinary skill in the art to combine rubber pads with Daninos' base as shown in Figs. 6 & 7. Applicant also argues that Figure 1 teaches away from adding a non-slip rubber pad under the base. The Examiner agrees that it would not make sense to add a non-slip rubber pad under the base of the embodiment shown in Figure 1. That is why the Examiner argues that it would have been obvious to combine a non-slip rubber pad to the base of the embodiment of Figs. 6 & 7 where a user would want a stable base while the footrest is rotated during exercise.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 3764

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam Nguyen whose telephone number is 571-272-4979. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cary O'Connor can be reached on 571-272-4715. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 12, 2007

Tam M. Nguyen
Examiner
3764



Cary E. O'Connor
Primary Examiner